

TRADEMARK
07-19214

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:
Chris Mentch, René Mentch

Serial Number: 76/678,599 Examining Attorney: Nancy Clarke

Filed: June 22, 2007 Law Office: 102

For: **SNOWBALL & POWDER**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

**REQUEST FOR RECONSIDERATION AFTER FINAL ACTION
UNDER TMEP §715.03**

I. Introduction

In response to the final office action mailed on April 17, 2008, Applicant respectfully submits this Request for Reconsideration After Final Action on the Examiner's refusal under Section 2(d) of the Trademark Act to register the subject mark. Applicant, however, does not waive its prior arguments regarding the Section 2(d) refusal.



10-20-2008

II. Likelihood of Confusion Refusal Under Section 2(d)

The Examiner has maintained her refusal under Section 2(d) of the Trademark Act because she believes that the proposed mark may cause a likelihood of confusion with U.S. Registration No. 2,239,806, and thus not entitled to registration.

For the reasons set forth below, Applicant respectfully requests reconsideration and withdrawal of the refusal under Section 2(d).

III. Withdrawal of the Section 2(d) Refusal is Warranted

Determination of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), is based on the factors compiled in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, it must be kept in mind that “[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of the differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

a. Applicant’s Mark and the Cited Mark Differ in Sound, Meaning and Commercial Impression

The Examining Attorney asserts that because both marks contain the term “SNOWBALL” that the two marks create similar commercial impressions and are confusingly similar. Applicant’s additional term “& POWDER” in Applicant’s mark creates a much different impression of the mark. In the instant case, the marks at issue

neither look nor sound alike. For example, Applicant's mark is substantially longer in both its visual appearance and pronunciation. Applicant's mark contains the phrase "SNOWBALL & POWDER" in its entirety and comprises three words having five syllables. In contrast, the cited mark, SNOWBALL, is a one-word mark comprising only two syllables. *See Chaussures Balley Society Anonyme de Fabrication v. Dial Shoe Co.* 145 USPQ. 488 (C.C.P.A. 1965)(Adding the word "LA", the word "the" in French and Italian, to Applicant's mark was enough to distinguish it from plaintiff's mark and avoid a "likelihood of confusion". [We] cannot dissect and set aside *any* portion of a mark and eliminate it from consideration in judging the matter of similarity or dissimilarity of competing marks") (emphasis added).

Applicant's mark, SNOWBALL & POWDER, and the mark in the cited registration have different connotations and commercial impressions. The term & POWDER in Applicant's mark imparts a meaning to the mark as a whole that is different from the meaning conveyed by SNOWBALL alone. The mark SNOWBALL & POWDER, as applied to Applicant's goods, has the connotation of imparting softness or a fine substance. The single term SNOWBALL alone has no similar connotation.

Inasmuch as there are differences in sound, appearance and meaning between the marks, when considered in their entireties, the differences outweigh any similarities. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d

1373, 47 USPQ2d 1459, 1460 (Fed.Cir. 1998) (“CRISTAL” and “CRYSTAL CREEK” evoke very different images in the minds of relevant consumers”).

In a Board decision in *In re Vast Resources, Inc., dba Topco Sales*, the Board reversed a Section 2(d) refusal concluding that “in spite of the fact that we are faced with overlapping goods moving through the same presumed channels of trade ultimately to be purchased by the same ordinary customers, we reverse this Section 2(d) refusal based upon the dissimilarity of the marks”.

b. The Respective Goods Are Not So Related That Confusion is Likely and the Examiner’s Exhibits Do Not Support that Consumers Purchasing Plush Toys Would Encounter Magnets or Dolls Depicting Harp Seals

The Examining Attorney also contends that Applicant’s goods are so related to the goods of the cited registration that confusion is likely.

Turning to the specific goods at issue, Applicant’s identification of goods does not recite “plush toys”. Further, although the Examiner contends that “plush toys” may broadly include magnets and dolls depicting harp seals, the mere fact that one may employ broad descriptive terms does not demonstrate that they are closely related. See, General Electric Co. v. Graham Magnetics Inc., 197 USPQ 690 (TTAB 1977). Further, the key question is whether the products/services differ in ways that are

material to consumers. See e.g., Butoni Foods Corp., v. Gio Buton & C.S.p.A., 680 F.2d 290, 292, 216 USPQ 558 (2nd Cir. 1982)(aperitif wines and table wines were not identical because differences between them was significant to consumers).

Even so, the Examining Attorney also attaches web pages from KB Toys to support her contention that plush toys, dolls and magnets could be located in the same store. Simply because similar goods can be found in the same large stores does not establish that consumers would be confused as to the source of the goods. Furthermore, the Examining Attorneys internet printouts indicate that consumers may purchase products based on brand name, by character, and by price, in which case consumers would not encounter registrant's goods if searched under these categories.

IV. Conclusion

The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. More than a mere possibility of confusion must be shown; instead there must be demonstrated a likelihood of confusion. *See, Electronic Design*, 954 F.2d 713, 21, USPQ2d at 1391.

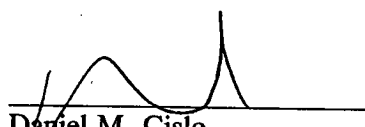
Applicant incorporates its previous arguments on the Section 2(d) refusal. Applicant respectfully requests that the Examiner reconsider the refusal in light of the arguments presented above and the previous arguments and pass the instant application to allowance.

TRADEMARK
07-19214

Respectfully submitted,

CISLO & THOMAS LLP

Date: October 16th 2008


Daniel M. Cislo
Reg. No. 32,973

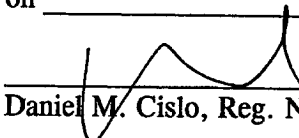
DMC:tr

CISLO & THOMAS LLP
1333 2nd Street, Suite 500
Santa Monica, California 90401-4110
Tel: (310) 451-0647
Fax: (310) 394-4477
www.cislo.com
T:\07-19214\REQUEST FOR RECONSIDERATION.DOC

CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that this correspondence (and any documents referred to herein)
is being deposited with the United States Postal Service as first class mail in an
envelope addressed to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

on 10-15-08

Daniel M. Cislo, Reg. No. 32,973 10-15-08 Date